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IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

No. 693

VICTOR DECOSTA, *Petitioner,*

v.

COLUMBIA BROADCASTING SYSTEM, INC., CAPITAL CITIES BROADCASTING CORPORATION and C B S FILMS INC., *Respondents.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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October 6, 1967

PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

The petitioner, Victor DeCosta, prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the First Circuit entered in this proceeding on May 11, 1967.

OPINION BELOW

The opinion of the United States Court of Appeals for the First Circuit is reported at 377 F.2d 315 and is reprinted in the Appendix hereto, p. 1a, *infra*. No opinion was rendered by the United States District Court for the District of Rhode Island.

JURISDICTION

The opinion and judgment of the Court of Appeals were entered on May 11, 1967. On timely application, Mr. Justice White on July 25, 1967, signed an order extending the time for filing this petition for writ of certiorari to and including October 7, 1967. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

QUESTIONS PRESENTED

1. Whether, as a matter of federal law, the creator of a personal or literary characterization is entitled to recover damages for the unfair appropriation of the creative effort and creative development devoted to that characterization.

2. Whether federal copyright law preempts any effort under state law to protect the creator of a personal or literary characterization against unfair appropriation of the creative effort and creative development devoted to that characterization.

3. Whether literary characters are copyrightable under the federal copyright laws and are encompassed within the copyright clause of the United States Constitution, Art. I, § 8, cl. 8.

4. Whether common law copyright protection of a literary characterization, as guaranteed by 17 U.S.C.

§ 2, can be considered abandoned by virtue of what a federal appellate court determines is a publication where (a) the jury has found, on proper instructions and with supporting evidence, that there was no publication, and (b) the so-called publication involved only one manifestation rather than the essence of the characterization.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

United States Constitution, Art. I, § 8, cl. 8:

The Congress shall have power . . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

United States Code, Title 17:

§ 1. *Exclusive rights as to copyrighted works*

Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right:

(a) To print, reprint, publish, copy, and vend the copyrighted work;

* * * * * * * * *

§ 2. *Rights of author or proprietor of unpublished work*

Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor.

§ 5. *Classification of works for registration*

The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs:

* * * * * * * * *

(g) Works of art; models or designs for works of art.

* * * * * * * * *

(k) Prints and pictorial illustrations including prints or labels used for articles of merchandise.

STATEMENT OF THE CASE

Petitioner, a citizen and resident of Rhode Island, instituted this suit in the United States District Court for the District of Rhode Island against the respondent foreign corporations, jurisdiction being grounded upon diversity of citizenship within the meaning of 28 U.S.C. § 1332. The first cause of action alleged in the third amended complaint, which was the only matter submitted to the jury, asserted that the respondent corporations had "substantially capitalized upon the idea and promotions of the Plaintiff, the Defendants . . . [having] failed to adequately compensate the Plaintiff for his services, by means of which the Defendants and each of them have become unjustly enriched." R.App. 14-16. Damages were accordingly sought in the amount of $2,000,000.

The jury was instructed, without objection by respondents, that petitioner was entitled to verdicts in his favor if he established (1) that he conceived and created the idea and character of "Paladin, Have Gun Will Travel", and that said idea and character were novel, original and unique, and that he did not

at any time abandon said idea and character by a publication thereof; (2) that the respondents copied said idea and character without petitioner's permission and used them in the television series entitled "Have Gun Will Travel"; and (3) that petitioner sustained damages as a result of such copying and use of said idea and character. R.App. 357; and see p. 7a, *infra.*

Based upon these instructions, the jury found in favor of the petitioner and awarded him verdicts in the sums of $100,000 against respondent, Columbia Broadcasting System, Inc., $10,000 against the respondent Capital Cities Broadcasting Corporation, and $40,000 against the respondent C B S Films Inc. R.App. 368. Respondents' motions for a directed verdict having been denied by the court at the close of petitioner's case, at the conclusion of all the evidence and after the jury verdicts, judgments for the stated sums were entered pursuant to Rule 54(b). R.App. 406-407. Separate appeals from the three judgments were taken to the First Circuit by the respondents, which appeals were consolidated. All three judgments were thereupon reversed.

The facts as found and believed by the jury are fairly summarized in the opinion of the First Circuit, see Appendix hereto, pp. 2a-5a, *infra,* and may be briefly stated as follows:

Petitioner is a Rhode Island mechanic who acquired a "passion for all things western" as a result of his early experiences as a Texas range hand and a resident of hobo jungles. Following two years of riding and roping he returned to Rhode Island and has since devoted himself to the mechanic's trade.

Beginning in 1947, petitioner indulged in his hobby of dressing in a western costume and riding on his horse in rodeos, horse shows, horse auctions and parades throughout New England. Being equipped with a moustache, he then selected a costume composed of a black shirt, black pants and a flat-crowned black hat to which was attached a St. Mary's medal. He adopted the name "Paladin" from an epithet once hurled at him by an onlooker of Italian descent. And from a cry uttered by another onlooker he acquired the phrase "Have Gun Will Travel."

Petitioner added further touches to his characterization. He used as his symbol a chess knight, designed from a piece he had acquired for fifteen cents at an auction. This symbol appeared on his holster and on his business cards. The cards also contained the words "Have", "Gun", "Will", "Travel" and "Wire Paladin, N. Court St., Cranston, R. I." An antique derringer was strapped under his arm during his performances.

Thus garbed and equipped, petitioner would appear at various functions—riding his horse, staging a western gunfight with his derringer, and passing out his business cards and photographs of himself. Some 250,000 of the cards were distributed. And in the words of the First Circuit, see p. 3a, *infra*: "Children clamored for the cards, and clustered about him to the extent that he was likened to the Pied Piper and Gene Autry. This was perhaps one of the purest promotions ever staged, for plaintiff did not seek anything but the entertainment of others. He sold no product, services, or institution, charged no fees, and exploited only himself."

Some ten years after petitioner began playing this role of Paladin he and his friends saw the first CBS television production of "Have Gun Will Travel", starring moustachioed Richard Boone as "an elegant knight errant of the Old West, always on the side of Good—for a fee." See pp. 3a-4a, *infra*. Like the petitioner, this television hero was named Paladin and wore a black costume, a flat-crowned black hat bearing an oval silver decoration, and a silver chess knight on his holster. And the television Paladin would announce himself with a card featuring a chess piece. This card was in most respects so identical with petitioner's as to be a "Chinese copy." It bore the words "Have Gun Will Travel, Wire Paladin, San Francisco." This "Have Gun Will Travel" series was a commercial success, grossing more than $14,000,000. There were 225 first-run episodes appearing in the United States and licensed in foreign countries.

Various witnesses for the respondent corporations testified that they had never seen or heard of the petitioner or his cards or his activities and that they had independently conceived and developed the television character of Paladin and all the accoutrements associated with him. See pp. 4a-5a, *infra*. Any similarities were said to be purely coincidental. But as the First Circuit noted, pp. 2a, 5a, *infra*, this was a case of "'coincidence' run riot. . . . The jury obviously disbelieved at least this much of their testimony, and we think it clear that they were amply justified. Thus, the plaintiff has had the satisfaction of proving the defendants pirates."

The First Circuit felt that the judgments allowing petitioner to recover a total of $150,000 were supportable only "on a rule of law that would allow recovery

upon proof of creation by the plaintiff and copying by the defendants, and nothing else." See p. 7a, *infra*. In finding no such rule and accordingly reversing the judgments, the First Circuit ruled that:

(1) The leading case affording a remedy for mere copying, *International News Service* v. *Associated Press,* 248 U.S. 215, is no longer authoritative since (a) it was decided as a matter of general federal law prior to the ruling in *Erie R.R.* v. *Tompkins,* 304 U.S. 64, and (b) it has been overruled by the recent decisions in *Sears, Roebuck & Co.* v. *Stiffel Co.,* 376 U.S. 225, and *Compco Corp.* v. *Day-Brite Lighting, Inc.,* 376 U.S. 234.

(2) While the *Sears* and *Compco* decisions dealt with copying articles covered by invalid design patents, their rationale covers the copying of "writings" as referred to in the copyright provision of the United States Constitution, Art. I, § 8. And hence "writings" that have not been subjected to the Congressional scheme of protection by notice and registration are controlled by "the federal policy favoring free dissemination of intellectual creations." See p. 9a, *infra*. Such "writings" cannot be protected against copying by others.

(3) There come a point, and it may have been reached here, "where what is created is so slight a thing as not to warrant protection by any law." See p. 11a, *infra*.

(4) The business cards created and distributed by petitioner fully conveyed petitioner's characterization of "Paladin." As such, these cards were said to be unquestionably "writings" within the meaning of the copyright clause of the Constitution and were argu-

ably copyrightable under the copyright statute, 17 U.S.C. §§ 1, 5(g), 5(k). And while the jury had been instructed that it could find for the petitioner only if there had been no publication, the First Circuit ignored the jury determination and proclaimed that the passing out of the cards over the years to all who would have them constituted a publication by petitioner; hence petitioner was precluded from seeking protection under 17 U.S.C. § 2, which permits the owner of an unpublished work to invoke common law and equitable remedies to prevent copying.

(5) Thus since the business cards had not been copyrighted, the *Sears* and *Compco* decisions were said to preclude petitioner from seeking to recover from respondents the monetary value of the creation and development of the "Paladin" characterization which the jury found had been stolen from petitioner. See p. 13a, *infra*.

REASONS FOR GRANTING THE WRIT

The critical premise of the First Circuit's decision in this case is the notion that this Court's recent rulings in *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 225, and *Compco Corp.* v. *Day-Brite Lighting, Inc.*, 376 U.S. 234, both of which dealt exclusively with invalid design patent matters, automatically and without qualification apply to works or writings that either fall or arguably fall within the ambit of the copyright clause of the Constitution and the copyright laws of the United States.

That premise is at best dubious. But the immediately pertinent fact is that this basic assumption, augmented by the precise rulings of the First Circuit, betrays several significant problems warranting this

Court's attention and consideration. Those problems, moreover, are not unique to this case; they have plagued all lower courts dealing with copyright matters in the post-*Sears-Compco* era. And the perplexities will remain until this Court definitively outlines the relationship of the *Sears-Compco* preemption doctrine to the copyright area.

1. Has the International News Service Decision Been Drained of Authoritativeness?

The First Circuit conceded that the decision of this Court in *International News Service* v. *Associated Press,* 248 U.S. 215, is "the leading case affording a remedy for mere copying." But that decision was said to be "no longer authoritative for at least two reasons: it was decided as a matter of general federal law before the decision in *Erie R.R.* v. *Tompkins,* 304 U.S. 64; and . . . it has clearly been overruled by the Supreme Court's recent decisions in *Sears, Roebuck & Co.* v. *Stiffel Co.,* 376 U.S. 225, and *Compco Corp.* v. *Day-Brite Lighting, Inc.,* 376 U.S. 234." See pp. 7a-8a, *infra.* Thereby raised are the following important questions deserving of this Court's concern:

(a) *International News Service* was indeed grounded on diversity jurisdiction, see 248 U.S. at 232, and presumably expressed a pre-*Erie* rule of general federal law. But if *Sears* and *Compco* are to be interpreted or extended to cover copyright situations, a serious problem is raised whether the resulting federal preemptive interest justifies the creation and continuation of federal rules of misappropriation in such copyright areas as were involved in *International News Service.*

The Court's opinion in *International News Service* exhibited complete awareness of the copyright provi-

sions of the Constitution and the provisions of the federal Copyright Act. The Court there carefully noted that its determination was not affected by any "showing that the benefits of the Copyright Act have been waived." 248 U.S. at 235. In other words, the result there reached was found to be consistent with the federal constitutional and statutory concepts governing copyrights. Nothing therein was thought to preclude protecting the Associated Press' interest in the "expenditure of labor, skill, and money" involved in the acquisition of written news material in a situation where an appropriator sought "to reap where it has not sown." 248 U.S. at 239.[1] And so in the instant case it could be concluded that to permit petitioner to be protected against respondents' piratical misappropriation of petitioner's creative efforts would in no real way be inconsistent with federal copyright concerns.

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[1] "The Copyright Act permits copyright protection against exact reproduction, but such protection does not preclude the public from using the factual information conveyed by the story. It seems clear that the Constitution permits this limited protection and that the states are precluded. But the Copyright Act would not seem to proscribe the INS practice of using the AP stories as a source of the underlying information and as the basis for its news stories, for the act does not protect the industry and judgment that the AP members expend in the gathering and selecting of facts. Judgment and industry are not 'writings'; the basic work of the reporter, like the results of the scientist and the mathematician, must, under the constitutional scheme, be available to the public, at least insofar as congressional power is concerned. The states are, therefore, free to grant protection similar to that which they may grant to other nonwriting elements, subject to possible limitations arising from the constitutional guarantee of freedom of the press." Kalodner and Vance, The Relation Between Federal and State Protection of Literary and Artistic Property, 72 Harv. L. Rev. 1079, 1106 (1959).

At the same time, however, the relationship between the misappropriation of creative nonwriting efforts and the precise copying of copyrightable material which is the concern of the Copyright Act may be considered so close as to justify encompassing both matters under the federal preemptive umbrella. Assuming *Sears* and *Compco* are to be fully applicable to the copyright field, this may then be a situation where the *Erie* doctrine has been held to be inapplicable, it being one of "those areas of judicial decision within which the policy of the law is so dominated by the sweep of federal statutes that legal relations which they affect must be deemed governed by federal law having its source in those statutes, rather than by local law." *Sola Electric Co.* v. *Jefferson Electric Co.*, 317 U.S. 173, 176. And in those situations like the present one where no precise answer is found in the federal statute, it becomes "the duty of the courts to be alert to provide such remedies as are necessary to make effective the congressional purpose." *J. I. Case Co.* v. *Borak*, 377 U.S. 426, 433.

The present case affords a convincing illustration of the need for and appropriateness of applying a uniform federal rule of misappropriation of material within the potential copyright realm. As indicated in footnotes 3 and 7 of the First Circuit's opinion, pp. 5a, 9a, *infra*, no single state's law can effectively cover a multi-state tort such as is here involved; there are grave difficulties involved even in determining which law of a state to apply—the local substantive law or the local conflicts law. See also *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111, 113, note 1, a post-*Erie* case where federal precedents were utilized. Thus it becomes essential that this Court lay down basic guidelines for establishing uniform federal rules

of law in this area, rules which very well may include the *International News Service* doctrine. Only in that way can incompatible and inconsistent doctrines of local law be avoided, once the *Sears-Compco* preemptive doctrine has been recognized in the copyright area. Cf. *Colorado Anti-Discrimination Comm'n* v. *Continental Air Lines*, 372 U.S. 714, 722; *Teamsters Union* v. *Morton*, 377 U.S. 252, 258.

(b) A closely related problem raised by the First Circuit's decision is whether this Court in *Sears* and *Compco* "clearly . . . overruled" the *International News Service* determination. Certainly no mention was made of that determination in either the *Sears* or the *Compco* opinion.[2] And the obvious differences between the design patent context of *Sears* and *Compco* and the copyright context of *International News Service* may well have induced this Court to defer any reconsideration of *International News Service* until compelled to do so in a case unavoidably presenting the question whether the federal copyright laws preempt any common law effort to prevent copying or appropriation of written material.[3]

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[2] It has been said that "Our understanding of Sears and Compco would be greatly increased, if only the Court had mentioned I.N.S." Bricker, Thirty Months After Sears and Compco, 14 Bull. Copyright Soc'y 293, 300 (1967). But it has also been said that "It would not be sensible to suppose that all of the precedents [including *International News Service*] have been displaced, *sub silentio*, by these two opinions." Bender, in Symposium—Product Simulation: A Right or a Wrong, 64 Colum. L. Rev. 1228, 1238 (1964).

[3] "American legal thinking on the subject of intellectual property has suffered, *ab initio*, from the lazy man's impulse to treat patents and copyrights alike, without a careful consideration of the vital differences between them." Whicher, The Ghost of Donaldson v. Beckett: An Inquiry Into the Constitutional Distribution of Powers Over the Law of Literary Property in the United States, 9 Bull. Copyright Soc'y 102, 194 n.4 (1962).

To permit a lower court to proclaim under these circumstances that *International News Service* has "clearly" been overruled is to encourage doubt, confusion and inconsistency among lower courts. Even in this post-*Sears-Compco* period, the *International News Service* ruling has been frequently cited and followed by lower courts seeking to protect the misappropriation of literary and written work.[4] Judges as well as litigants are now entitled to know whether in fact the *International News Service* decision has been overruled or whether the First Circuit's *ipse dixit* to that effect may safely be ignored.

2. Should the Sears-Compco Preemption Doctrine Be Applied Indiscriminately to the Copyright Area?

Since both *Sears* and *Compco* were concerned solely with products susceptible to whatever protection federal patent law alone might provide, there was no occasion for the Court to rule definitively on the preemptive reach of federal copyright law. Nevertheless, certain broad observations appear in both opinions relative to the relationship between federal copyright

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[4] Among such recent decisions utilizing the *International News Service* precedent are *Pottstown Publishing Co.* v. *Pottstown Broadcasting Co.*, 247 F. Supp. 578 (E.D. Pa.); *Flexitized, Inc.* v. *National Flexitized Corporation*, 335 F.2d 774 (C.A. 2); *The Bond Buyer* v. *The Dealers Digest Publishing Co., Inc.*, 25 App. Div. 2d 158, 267 N.Y.S. 2d 944; *Flamingo Telefilm Sales, Inc.* v. *United Artists Corp.*, 141 U.S.P.Q. 461 (N.Y. Sup. Ct.).

law and state law of unfair competition.[5] These statements are epitomized by the sentence in *Compco,* 376 U.S. at 237, reading: "Today we have held in *Sears, Roebuck & Co.* v. *Stiffel Co., supra,* that when an article is unprotected by a patent *or a copyright,* state law may not forbid others to copy that article." [Emphasis added.]

Some lower courts have stressed that these copyright references are *obiter dictum.* See, e.g., *Pottstown Publishing Co.* v. *Pottstown Broadcasting Co.,* 247 F. Supp. 578, 580-581 (E.D. Pa.). Others have suggested that *Sears* and *Compco* were not designed to strike down common law copyright principles, which are preserved in § 2 of the Copyright Act and which are referred to in footnote 7 of the *Sears* opinion. 376 U.S. at 231. As stated in *Edgar H. Wood Associates, Inc.* v. *Skene,* 347 Mass. 351, 197 N.E. 2d 886, 890: "There is a distinction between that protection afforded under State unfair competition laws to the unpatented article in the public domain and the protection extended through common law copyright to an unpublished work."

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[5] The very first sentence in *Sears,* 376 U.S. at 225, states the issue to be whether a state unfair competition law may "prohibit the copying of an article which is protected by neither a federal patent nor a copyright." And after discussing patent policy and history, the Court in *Sears* concludes that "because of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying." 376 U.S. at 232-233. The *Compco* opinion, 376 U.S. at 237, added that "to forbid copying would interfere with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."

Indeed, contrary to the First Circuit's indiscriminate reading of the *Sears-Compco* decisions, it has been claimed that "the very fact that the federal copyright system is not so comprehensive as the patent law—passingly noted in *Sears*—suggests that the preemption principles expounded in *Sears* and *Compco* were not intended to resolve problems peculiar to the copyright law." Kestenbaum, The *Sears* and *Compco* Cases: A Federal Right To Compete by Copying, 51 A.B.A.J. 935, 938 (1965). Thus it may well be that *Sears* and *Compco*, dealing only with unpatented and uncopyrighted articles of a commercial or industrial nature, meant to emphasize only that such an "article . . . unprotected by a patent or copyright," may be freely copied. This would leave untouched by *Sears* and *Compco* those writings and literary characterizations that do not partake of the nature of commercial or industrial articles.

Moreover, with specific reference to the protectability of literary or artistic characters outside the federal copyright scheme, serious questions have been raised whether this Court in *Sears* and *Compco* meant to outlaw the extensive jurisprudence which has developed in federal and state courts protecting creators of characterizations against piracy. Did this Court mean, for example, to permit free appropriation by anyone of the effort and expense that went into the creation and development of such uncopyrighted and uncopyrightable characters as Mutt and Jeff,[6] the "Old

[6] Protection against unfair appropriation of these characters was afforded in *Fisher* v. *Star Co.*, 231 N.Y. 414.

Maestro,".[7] Frank Merriwell,[8] Stella Dallas,[9] Raggedy Ann,[10] Charlie Chaplin,[11] the Lone Ranger,[12] the Beatles,[13] and Wyatt Earp?[14] It has been said that running through all the cases giving protection to such characterizations is a single thread, i.e., "the character was associated with and therefore identified the author or the characterization identified the performer [and the] use by another of this identification was an invasion of the author's or the performer's right to his identity and it is this right which the courts protected." Waldheim, Characters—May They Be Kidnapped? 12 Bull. Copyright Soc'y 210, 215 (1965). But the ultimate and unanswered question is the one asked by this commentator (Waldheim, p. 217): "Does the Supreme Court imply by these cases [*Sears* and *Compco*] that the only rights inhering in a character are those which are afforded by the copyright law?"

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[7] Protection against appropriation was given in *Premier-Pabst Corporation* v. *Elm City Brewing Co.*, 9 F. Supp. 754 (D. Conn.).

[8] Protection afforded in *Patten* v. *Superior Talking Pictures, Inc.*, 8 F. Supp. 196 (S.D.N.Y.).

[9] Protection afforded in *Prouty* v. *National Broadcasting Co.*, 26 F. Supp. 265 (D. Mass.).

[10] Protection afforded in *Gruelle* v. *Molly-'Es Dolls Outfitters*, 94 F. 2d 172 (C.A. 3).

[11] Protection afforded in *Chaplin* v. *Amador*, 93 Cal. App. 358, 269 P. 544.

[12] Protection afforded in *Lone Ranger* v. *Cox*, 124 F. 2d 650 (C.A. 4).

[13] Protection afforded in *Remco Industries* v. *Goldberger Doll Mfg. Co.*, 141 U.S.P.Q. 898 (E.D.N.Y.).

[14] Protection afforded in *Wyatt Earp Enterprises* v. *Sackman*, 157 F. Supp. 621 (S.D.N.Y.).

The First Circuit has sought to answer that question in the affirmative. To do so, however, raises a host of complexities. To strip characterizations of all protection other than that afforded by the copyright laws of the United States is to allow a chilling breeze on First Amendment rights; unlike commercial products, literary creations partake of freedom of speech and press and to denude them of such protection may well inhibit creativity and expression. And such creations would not seem to fit within the normal concept of the commercial goods and articles which are involved in "the constitutional plan of a competitive economy," *Aro Mfg. Co.* v. *Convertible Top Co.*, 377 U.S. 476, 572 (Black, J.), the plan which *Sears* and *Compco* are designed to preserve.

Indeed, it is not at all clear the extent to which characterizations can claim the limited protection of the copyright laws.[15] And even if they can claim copyright protection, neither the copyright clause of the Constitution nor the Copyright Act does more than outlaw mere copying. Those provisions leave untouched and unpunished any piracy of the creative effort and development that ultimately make possible a copyrightable work. Hence to permit a state law of unfair competition to give protection against appropriation of such effort and development would not appear, in the words of *Sears*, 376 U.S. at 232, "to permit the State to block off from the public something which federal law has said belongs to the public." Federal law does not here say that the creative and

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[15] The best that can be said on this matter is that "the courts are in conflict on this issue." Nimmer on Copyright, § 30, p. 134.1 (1967). And see Waldheim, Characters—May They Be Kidnapped? 12 Bull. Copyright Soc'y 210 (1965).

developmental efforts underlying a literary characterization belong to the public. Or, as put in *Ferris* v. *Frohman*, 223 U.S. 424, 437, "It was not the purpose or effect of the copyright law to render secure the fruits of piracy."

It may fairly be said that the *Sears* and *Compco* decisions leave the law in this area of literary characterizations "in a confusing state". Bricker, Thirty Months After Sears and Compco, 14 Bull. Copyright Soc'y 293, 309 (1967). Already at least one federal district court has tried without success to interpret and apply *Sears* and *Compco* in terms of the protection now available to a literary characterization like Tarzan. *Edgar Rice Burroughs, Inc.* v. *Charlton Publications, Inc.*, 243 F. Supp. 731 (S.D.N.Y.). The First Circuit's efforts in the instant "Paladin" case are no more satisfactory.

Only this Court's consideration can bring any degree of certainty or clarity to this constantly recurring situation.[16]

3. What Copyright Protection Is Available to a Literary Characterization?

Neither courts nor commentators are in agreement as to the extent to which literary and artistic characterizations are subject to copyright protection, be it of the common law or federal statutory variety. The decision of the First Circuit in this case has only

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[16] *Sears* and *Compco*, according to one commentator, "have not been unanimously acclaimed by the lower courts. They have been treated sarcastically, doubtfully, and apparently incorrectly. For other courts sharp differences of opinion have arisen." [Citing cases.] Bricker, Thirty Months After Sears and Compco, 14 Bull. Copyright Soc'y 293, 302 (1967).

added to that confusion, making it appropriate for this Court to exercise its certiorari review power.

(a) In denying that literary characters are inherently uncopyrightable, see p. 10a, *infra*, the First Circuit has expressed a viewpoint in conflict with the view of the Ninth Circuit in *Warner Bros. Pictures* v. *Columbia Broadcasting System*, 216 F. 2d 945, and of a host of other federal courts.[17] While the First Circuit attempted to distinguish the *Warner* case on its facts, a plain reading of the Ninth Circuit's opinion reveals that it held that no character is protectible under the federal copyright law unless "the character really constitutes the story being told", and is not merely a "chess man in the game of telling the story"—in other words, there must be a "story" devoid of everything but a character study. 216 F. 2d at 950. No such "story" was involved in the instant case, thereby making the conflict complete.

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[17] Other lower federal courts that have held literary characterizations generally to be non-copyrightable include *Bobbs-Merrill* v. *Straus*, 147 F. 15 (C.A. 2); *Universal Pictures Co.* v. *Harold Lloyd Corp.*, 162 F.2d 690 (C.A. 2).

Contrary views have been expressed in such cases as *Lone Ranger, Inc.* v. *Cox*, 124 F.2d 650 (C.A. 4); *King Features Syndicate* v. *Fleisher*, 299 F. 533 (C.A. 2); and *Wilson* v. *Haber Bros.*, 275 F. 346 (C.A. 2).

As stated in Nimmer on Copyright, § 30, p. 134.1 (1967), where all the conflicting decisions are cited, these courts "are in conflict on this issue," although an argument can be made that there is a degree of reconcilability in terms of the degree to which a character has been delineated in a literary work. As stated by Judge Learned Hand in *Nichols* v. *Universal Pictures*, 45 F.2d 119, 121 (C.A. 2), "the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly."

Indeed, the general or majority view of courts and commentators always has been that "ordinarily, of course, there is no copyright protection in a character as such" [18]—which is precisely what the petitioner here created and nothing more. And it is significant that the Federal Register of Copyrights, in reporting to the House Committee on the Judiciary on proposed revisions of the federal copyright law, has stated that "we believe it would be unnecessary and misleading to specify fictional characters as a separate class of copyrightable works." [19] He thereby implied that characters as such are not now copyrightable and should not be made copyrightable.

There is an obvious need for clarification of this problem by this Court.

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[18] Waldheim, Characters—May They Be Kidnapped? 12 Bull. Copyright Soc'y 210 (1965). See also *Burtis* v. *Universal Pictures*, 40 Cal. 2d 823, 256 P.2d 933: "Although it might be possible that an author could so carefully delineate a character as to secure a protectible property interest in that character, generally it is held that a character is not included within the monopoly of copyright."

[19] His full statement reads: "Proposals have been advanced for identifying fictional characters as copyrightable works in themselves under the bill. There are undoubtedly some characters that are developed in detail and with such breadth and depth that they emerge as separately identifiable parts of the copyrighted works in which they appear. Others, perhaps the large majority, cannot be said to represent independent creations apart from the particular literary or pictorial works depicting them. As is equally true in the case of detailed presentations of plot, setting, or dramatic action, we believe it would be unnecessary and misleading to specify fictional characters as a separate class of copyrightable works."

Copyright Law Revision, Part 6, Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1965 Revision Bill, House Committee on the Judiciary Print, 89th Cong., 1st Sess. (May 1965), p. 6.

(b) An integral part of the First Circuit's ruling that petitioner's characterization of Paladin was copyrightable is its insistence (see pp. 11a, 13a, *infra*) that such characterization involves a "writing" within the meaning of federal copyright law. But in trying to define the form of "writing" which a characterization may take for copyright purposes, the court has only compounded the confusion over the copyrightability of literary characters.

Ignoring the general rule that a creation must involve some identifiable, durable and material form to be copyrightable,[20] the First Circuit has said first that congressional power over copyright matters is not so limited. But the court is not certain precisely what aspect of a personal characterization becomes subject to that legislative power. The court suggests it would not be "impracticable" to provide for a procedure for registering "characters" by filing some sort of pictorial or narrative description—a suggestion which the Register of Copyrights has found to be wholly impracticable and unwise. Finally, almost in desperation, the First Circuit has concluded that perhaps we have here reached the point "where what is created is so slight a thing as not to warrant protection by any law . . . [and] ineligible for protection against copying *simpliciter* under either state or federal law." See pp. 11a-12a, *infra*.

Thus the First Circuit finally seems to be saying, contrary to its own earlier statements, that personal or literary characterizations are inherently uncopyrightable and not entitled to any sort of legal protection.

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[20] See Nimmer, Copyright Publication, 56 Colum. L. Rev. 185, 196 (1956).

But if that be true, what becomes of the federal preemptive interest which the court has found to be so great as to bar any relief in this case under state law? If the subject matter is "so slight a thing" as to be ineligible for federal protection, what power does a federal court have to declare it to be ineligible for state protection? These are only a few of the questions arising from the First Circuit's strange ruling. Left unchallanged, that ruling can only breed chaos and uncertainty in the field of literary characterization.

(c) Finally, the First Circuit's conclusion that petitioner's creation was not an unpublished work under 17 U.S.C. § 2 and hence was not protectible under common law copyright doctrines creates conflicts with principles announced by this Court and raises important issues fully justifying this Court's concern.

In holding that petitioner had abandoned his characterization by performing in public and handing out business cards to all who would take them, the First Circuit (1) overrode the jury's unchallenged determination, based on record evidence (R. App. 78-80, 98-99, 106, 154) as to the limited purpose and intent of the distribution, that there had been no publication and (2) redefined *de novo* the characterization so as to fit completely within the portrayals and wording of the business cards. The court thereupon held that the cards were the "writings" that had been published for purposes of § 2 and that could have been but were not copyrighted.

Such a ruling only underscores and augments the internal confusion in the First Circuit's opinion over what if any aspect of a characterization is a copy-

rightable "writing." More importantly, however, the court has ignored certain basic principles recognized by this Court:

(1) To constitute a publication in the copyright sense, there "must be such a dissemination of the work of art itself among the public as to justify the belief that it took place with the intention of rendering such work common property." *American Tobacco Co.* v. *Werckmeister,* 207 U.S. 284, 299-300. Since that issue is largely a factual one, the jury's verdict—assuming proper instructions and sufficient evidence—must be respected by an appellate court in order to avoid a collision with the Seventh Amendment. See *Arnold* v. *Panhandle & S.F.R. Co.,* 353 U.S. 360; *A. & G. Stevedores* v. *Ellerman Lines,* 369 U.S. 355.

(2) The mere "public presentation of a dramatic composition, not printed and published, does not deprive the owner of his common-law right . . . [or] an abandonment of it to the public use." *Ferris* v. *Frohman,* 223 U.S. 424, 435.[21] That basic principle should not be avoidable by the technique employed by the First Circuit, i.e., seizing upon one printed facet of a many-faceted characterization and elevating it into the sole characteristic. Actually the cards were mere adjuncts in aid of petitioner's public performances, which under the *Ferris* doctrine were properly found by the jury not to constitute publication or abandonment of

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[21] The cases that have employed this principle are legion. See, e.g., *Columbia Broadcasting System* v. *Documentaries, Unlimited,* 248 N.Y.S. 2d 809 (N.Y. Sup. Ct.), where one of the respondents in the instant case successfully urged that a public broadcast of a news announcement, presumably heard by millions of citizens, did not constitute an abandonment of common law copyright by publication.

the character. At most the cards, which might also qualify as trademarks or service marks, served to reinforce and strengthen the secondary meaning that attached to petitioner in his unabandoned role of Paladin. The cards themselves were not the characterization as viewed by the jury and their so-called publication could not as a matter of law constitute an abandonment of the characterization. In these circumstances, the *Ferris* rule should have been followed.

CONCLUSION

For these various reasons, a writ of certiorari should issue to review the judgment and opinion of the First Circuit in this case.

Respectfully submitted,

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October 6, 1967

APPENDIX

UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

No. 6769

COLUMBIA BROADCASTING SYSTEM, INC.,
Defendant, Appellant,

v.

VICTOR DECOSTA, *Plaintiff, Appellee.*

No. 6770

CAPITAL CITIES BROADCASTING CORPORATION

v.

SAME

No. 6771

CBS FILMS INC.

v.

SAME

APPEALS FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF RHODE ISLAND

Before ALDRICH, *Chief Judge,*
MCENTEE and COFFIN, *Circuit Judges.*

Knight Edwards, with whom *Ronald R. Lagueux, Carleton G. Eldridge, Jr., Eugene L. Girden, Edwards & Angell* and *Coudert Brothers* were on brief, for appellants.

Leonard Decof, with whom *Alan T. Dworkin* and *Aisenberg, Decof & Dworkin* were on brief, for appellee.

May 11, 1967

COFFIN, *Circuit Judge.* This is an appeal by defendants[1] from jury verdicts in the total amount of $150,000 awarded plaintiff on his claim that he created, and the defendants misappropriated, the character of Paladin, the protagonist of the CBS television series entitled "Have Gun Will Travel".

The story of this case—more bizarre than most television serial installments—is one of "coincidence" run riot. The plaintiff, of Portugese parents, is a Rhode Island mechanic whose formal education ceased after the fourth grade. During the Depression, having tired of factory work, he hopped a freight for the West, lived in hobo jungles, and eventually became a range hand on a Texas ranch. After two years of riding and roping he returned to Rhode Island to work as a mechanic and later received training as a motor machinist in the Coast Guard. But he retained his passion for all things western. In 1947 he began to participate in rodeos, horse shows, horse auctions, and parades.

From the beginning plaintiff indulged a penchant for costume. He was already equipped with a moustache. He soon settled on a black shirt, black pants, and a flat-crowned black hat. He had acquired a St. Mary's medal at a parade and affixed this to his hat. He adopted the name Paladin after an onlooker of Italian descent had hurled an epithet at him containing the word "Paladino". On looking up the word Paladin in a dictionary he found it meant "champion of Knights" and was content that

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[1] The three defendants are Columbia Broadcasting System, Inc., producer of the television series at issue, CBS Films, Inc., a wholly owned subsidiary of the System responsible for licensing the series; and Capital Cities Broadcasting Corporation, owner of several broadcasting stations showing the series in several states. For convenience we shall refer to them simply as CBS or defendants.

people began so to call him.[2] One day when he had donned his custome in preparation for a horse show, and was about to mount his horse, one of a group waiting for him shouted "Have Gun Will Travel", a cry immediately picked up by the children present.

The finishing touches were a chess knight, bought for fifteen cents at an auction, which plaintiff thought was a good symbol, and which he used on a business card along with the words "Have", "Gun", "Will", "Travel", and "Wire Paladin, N. Court St., Cranston, R.I.", hand-printed with separate rubber stamps; a silver copy of the chess piece on his holster; and an antique derringer strapped under his arm. So accoutered, he would appear in parades, the openings and finales of rodeos, auctions, horse shows, and a pony ring he once operated. From time to time at rodeos he would stage a western gunfight, featuring his quick draw and the timely use of his hidden derringer. He would pass out photographs of himself and cards—printed versions soon replacing the rubber-stamped ones. Hospitals, drug stores, barber shops, sports shops, diners —all were the repositories of his cards, some 250,000 of them. Children clamored for the cards, and clustered about him to the extent that he was likened to the Pied Piper and Gene Autry. This was perhaps one of the purest promotions ever staged, for plaintiff did not seek anything but the entertainment of others. He sold no product, services, or institution, charged no fees, and exploited only himself.

Ten years after he had begun to live his avocational role of Paladin, he and his friends saw the first CBS television production of "Have Gun Will Travel", starring moustachioed Richard Boone, who played the part of an elegant knight errant of the Old West, always on the side

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[2] Other names he had been called were Kid Hollywood, Fidel, Gabby Hayes, the Wild Cowboy from the Southwest, and Paladino.

of Good—for a fee. The television Paladin also wore a black costume, a flat-crowned black hat bearing an oval silver decoration, and a silver chess knight on his holster, and announced himself with a card featuring a chess piece virtuallly—if not absolutely—identical with the plaintiff's and the words "HAVE GUN WILL TRAVEL, WIRE PALADIN, SAN FRANCISCO". The series was notably successful; it appeared in 225 first-run episodes in the United States, was licensed in foreign countries, and by the time of trial had grossed in excess of fourteen million dollars.

The writers and network executives responsible for the series testified in detail that the television Paladin was a spontaneous creation, developed in total ignorance of the attributes of his Rhode Island predecessor. The writers, Herb Meadow and Sam Rolfe, testified that the germ of the idea was the title, "Have Gun Will Travel", which Meadow had evolved from mulling over a familiar theatrical advertising phrase, "Have tux, will travel". The character was originally conceived as a denizen of contemporary New York, but was changed to a western hero because the network hoped to cast Randolph Scott in the role. The name "Paladin" resulted from a thesaurus search for words meaning "knight" or "hero" or "champion". The chess piece symbol was inspired by Meadow's observation, while teaching his son the game, that the knight's movements were uniquely erratic and unpredictable. In the pilot script for the series, Paladin used a hidden derringer because it was a convenient way to extricate him from the obligatory dangerous situation.

The show's original producer, Julian Claman, testified that after Randolph Scott and other "fairly well known" actors were found to be unavailable he selected Richard Boone to be tested for the role of Paladin. Boone appeared for the test with a moustache, for reasons unknown, and was outfitted in a black suit because it was the only available costume that fitted. The hat, bearing a silver "conche", was selected by Claman because it looked ap-

propriate. The card, which had been described in Meadow and Rolfe's original prospectus, was realized by the CBS art department from a rough sketch by Claman. The "shocking similarity" to DeCosta's cards was pure coincidence. Boone's test was successful, and Claman, reluctant to change any element of a winning combination, decided to keep card, costume, and moustache intact for the pilot film. He also decided to add the silver chess knight to Paladin's holster because it produced a distinct article that would be marketable if the series succeeded.

Meadow, Rolfe, Claman, and the other witnesses for the defendants all testified that they had never seen DeCosta or any of his cards. The jury obviously disbelieved at least this much of their testimony, and we think it clear that they were amply justified. Thus, the plaintiff has had the satisfaction of proving the defendants pirates. But we are drawn to conclude that that proof alone is not enough to entitle him to a share of the plunder. Our Paladin is not the first creator to see the fruits of his creation harvested by another, without effective remedy; and although his case is undeniably hard, to affirm the judgments below would, we think, allow a hard case to make some intolerably bad law.

In the first place, it is by no means clear that such state law of intellectual property as we have found supports relief on these facts.[3] Several cases have been cited

[3] Since this action was tried in the District of Rhode Island, the governing law must be the substantive law of Rhode Island or of the state indicated by Rhode Island's choice-of-law rules. But no authority from Rhode Island has been cited or found. Thus, the cases from other jurisdictions are at best persuasive in estimating what the law of Rhode Island might be; and the difficulty of applying one state's rule to a "tort" that, like this, affects the interests of many states, *see Capitol Records, Inc.* v. *Mercury Records Corp.*, 2 Cir., 1955, 221 F. 2d 657, 667 (L. Hand, J., dissenting), might well leave the issue in doubt even if another jurisdiction provided a case directly in point.

around the general proposition that it is an actionable wrong to appropriate and exploit the product of another's creative effort; but all seem to involve distinguishable wrongs of at least equal or even superior significance. Most rest on the tort of "passing off": appropriation not of the creation but of the value attached to it by public association (the so-called "secondary meaning"), by misleading the public into thinking that the defendant's offering is the product of the plaintiff's established skill. *E.g., Lone Ranger, Inc.* v. *Cox*, 4 Cir., 1942, 124 F.2d 650; *Chaplin* v. *Amador*, 1928, 93 Cal. App. 358, 269 Pac. 544.[4] Others add an element of injury to reputation caused by a poor imitation. *E.g., Lahr* v. *Adell Chem Co.*, 1 Cir., 1962, 300 F.2d 256. And at least one combined both of these with an element of injury to a valuable contract to assert "the broader principle that property rights of commercial value are to be and will be protected from any form of unfair invasion or infringement and from any form of commercial immorality . . . ." *Metropolitan Opera Ass'n* v. *Wagner-Nichols Recorder Corp.*, Sup. Ct., 1950, 199 Misc. 786, 793, 101 N.Y.S. 2d 483, 492.

Plaintiff argues that he has established "secondary meaning" through testimony of some witnesses that they thought he was the Paladin on television and evidence that most people knew him only as Paladin, not as Victor DeCosta. Whether or not this assertion is true, it is here irrelevant, for the issue was not submitted to the jury. The complaint alleged three causes of action: misappropriation, trade and/or service mark infringement, and unfair competition by "passing off" the television Paladin

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[4] The plaintiff quotes the *Lone Ranger* case as involving "the element of fraudulent attempt of someone to 'reap where he has not sown' and to appropriate to himself 'the harvest of those who have sown'." 124 F. 2d at 653. But the opinion makes it clear that the "harvest" is the goodwill generated by long establishment of the Lone Ranger in the public eye, and the element of fraud is quite as important as the element of appropriation.

as the plaintiff. Only the first was tried, the court reserving judgment on defendant's motions to dismiss the other two. The jury was instructed that the plaintiff would be entitled to the verdict if he established:

> "First. That he conceived and created said idea and character of 'Paladin, Have Gun Will Travel'; and that said idea and character was novel, original, and unique; and that he did not at any time abandon said idea and character by a publication thereof.
>
> "Second. That the defendants . . . did copy said idea and character without the permission of the plaintiff and used them in the television series, 'Have Gun Will Travel.'
>
> "Third. That the plaintiff sustained damages as a result of such copying and use of said idea and character . . . ."

Thus, the judgment can only be supported on a rule of law that would allow recovery upon proof of creation by the plaintiff and copying by the defendants, and nothing else. We do not find such a rule in the cases cited above.

Moreover, the leading case affording a remedy for mere copying, *International News Serv.* v. *Associated Press*, 1918, 248 U.S. 215, is no longer authoritative for at least two reasons:[5] it was decided as a matter of general federal law before the decision in *Erie R.R.* v. *Tompkins*, 1938, 304 U.S. 64; and, as it prohibited the copying of published written matter that had not been copyrighted (indeed, as news it could not be copyrighted, 248 U.S. at 234), it has clearly been overruled by the Supreme Court's recent decisions in *Sears, Roebuck & Co.* v. *Stif-*

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[5] *See also Cheney Bros.* v. *Doris Silk Corp.*, 2 Cir., 1929, 35 F. 2d. 279, 280 (L. Hand, J.): ". . . there are cases where the occasion is at once the justification for, and the limit of, what is decided. This [*INS*] appears to us such an instance . . . ."

fel Co., 1964, 376 U.S. 225, and *Compco Corp* v. *Day-Brite Lighting, Inc.*, 1964, 376 U.S. 234. While this normally would not prevent the state court from adopting the reasoning of *INS* in fashioning a rule of state law, we think it important to consider the scope of state power in this area in view of *Sears* and *Compco*.

It is true that *Sears* and *Compco* both deal with copying of articles covered by invalid design patents. But the opinions refer throughout to both copyright and patent; and in *Compco* the Court took pains to articulate the broad scope of its decisions:

> "Today we have held . . . that when an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article. To forbid copying would interfere with the federal policy, found in Art. I, § 8 cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain." 376 U.S. at 237.

More fully, that policy is to encourage intellectual creation by offering the creator a monopoly in return for the disclosure and eventual surrender of his creation to the public.[6]

Does the language in *Compco*, "whatever the federal patent and copyright laws leave in the public domain", refer to creations that Congress has deliberately chosen not to protect or more broadly to those it has simply not protected, whether by choice or by chance? In the case of patents the two questions are coterminous, for Congress

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[6] U.S. Const. art. I, § 8, cl. 8:

> "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;" *See also Graham* v. *John Deere Co.*, 1966, 383 U.S. 1, 5-10.

has deliberately chosen not to protect inventions lacking the element of originality, and an invention is thus either patentable or unprotectible. In the case of "writings" there is no such universal test of qualification. But Congress has established a procedural scheme of protection by notice and registration. The necessary implication of this approach, we conclude, is that, absent compliance with the scheme, the federal policy favoring free dissemination of intellectual creations prevails. Thus, if a "writing" is within the scope of the constitutional clause, and Congress has not protected it, whether deliberately or by unexplained omission, it can be freely copied. *See Cheney Bros.* v. *Doris Silk Corp.*, 2 Cir., 1929, 35 F.2d 279.

The compelling reasons for this rule are well stated in Judge Learned Hand's prophetic dissent in *Capitol Records, Inc.* v. *Mercury Records Corp.*, 2 Cir., 1955, 221 F.2d 657, 664-67, where he referred to (1) the anomaly of allowing a creator to acquire a perpetual monopoly of his work under state law when he cannot obtain the limited right of exploitation under federal law, and (2) the impossibility of affording effective protection against copying except by a uniform national law.[7] *See also RCA Mfg. Co.* v. *Whiteman*, 2 Cir., 1940, 114 F.2d 86, 89-90.

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[7] This case presents the problem very well. Counsels' failure to address it in their briefs is a tribute to its perplexity. Here a Rhode Island plaintiff performed in Rhode Island, Connecticut, Maine, Massachusetts, and New York, and once gave a batch of his cards to a truckdriver heading west. Can Rhode Island law effectively prohibit copying from a performance in New York or from a card carried to California by a person who may have received it in Kansas? Would Rhode Island resolve the choice of law question by inquiring whether California, the site of the television series, would prohibit the copying? If so, should California law apply to govern the rights of people in, say, Arkansas to view the intellectual "property" of a Rhode Island citizen, stolen perhaps in Connecticut, perhaps in Kansas, certainly in parts unknown?

To this plaintiff gives two answers. He argues that a character is not copyrightable—by which we must understand that it is not within the scope of Congress's power under the copyright clause—and that in any event a creation in the form of a public performance is protectible as an unpublished work under 17 U.S.C. § 2.[8] For the first proposition the authority cited is *Warner Bros Pictures, Inc.* v. *Columbia Broadcasting Sys.*, 9 Cir., 1954 216 F.2d 945, which held that the assignee of the copyright of the novel *The Maltese Falcon* could not prevent the author from using the character Sam Spade in a sequel. But that case is inapposite, because it held only (a) that the contract of assignment did not convey the exclusive right to use of the characters in the novel, and (b) that the sequel, *The Kandy Tooth*, was not so similar as to infringe the copyright. That is far from saying that characters are inherently uncopyrightable.[9]

A more substantial argument for this first proposition is that the plaintiff's creation is not a "writing" in the

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[8] "Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor."

[9] *Cf. Nichols* v. *Universal Pictures Corp.*, 2 Cir., 1930, 45 F. 2d 119, 121:

> "... If Twelfth Night were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare's 'ideas' in the play, as little capable of monopoly as Einstein's Doctrine of Relativity, or Darwin's theory of the Origin of Species. It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly."

sense used in the copyright clause (or, what is the same thing, that it is not an "article" in the sense used in *Sears* and *Compco*). There is no question that the term is to be interpreted more broadly than its common meaning would indicate. *See, e.g., Mazer* v. *Stein,* 1954, 347 U.S. 201 (statuette used as a lamp base). But it has been argued that it should be limited to mean some identifiable, durable, material form. Nimmer, *Copyright Publication,* 56 Colum. L. Rev. 185, 196 n. 98 (1956). And it is argued here that the plaintiff's creation, being a personal characterization, was not reduced and could not be reduced to such a form.

To this argument there are several answers. First, while more precise limitations on "writings" might be convenient in connection with a statutory scheme of registration and notice, we see no reason why Congress's power is so limited. Second, we cannot say that it would be impracticable to incorporate into the copyright system a procedure for registering "characters" by filing pictorial and narrative description in an identifiable, durable, and material form. Finally, however, there comes a point where what is created is so slight a thing as not to warrant protection by any law. All human beings—and a good part of the animal kingdom—create characters every day of their lives. Individuals often go beyond the realm of unconscious creation and devise characterizations for their own and others' amusement. Many a starred performer has so begun, and continued to grow on the borrowings from others. At some point his innate talent and eclectic poaching may enable him to attract a following, and ultimately to secure the law's protection against imitators. At what point short of this there should be additional protection we do not say. But in view of the federal policy of encouraging intellectual creation by granting a limited monopoly at best, we think it sensible to say that the constitutional clause extends to any concrete, describable manifestation of intellectual

creation; and to the extent that a creation may be ineffable, we think it ineligible for protection against copying *simpliciter* under either state or federal law.

For the second proposition, that the plaintiff's creation is an unpublished work protected under 17 U.S.C. § 2, the leading authority is *Ferris* v. *Frohman*, 1912, 223 U.S. 424, which held that the public performance of a play did not constitute publication in the sense of an abandonment to public use. But in that case the Court specifically noted that the play involved had not been "printed and published"; that is, no copies of the script had been distributed publicly.[10]

Here, plaintiff's "performance" consisted of two components: appearing in public and passing out cards and photographs. No other "action" was involved, except an occasional "quick draw" demonstration at a rodeo. So far as his costume and menacing appearance were concerned, it was fully conveyed on the cards bearing his photograph—which also contained the chess piece, the slogan, and the name "Paladin". The cards were passed out in great quantities over the years to all who would have them. So far as any action accompanying his personal appearance is concerned, whether it be simply riding a horse, or staging a quick-draw gun fight, these are hallowed shelf items in the tradition of the early West. In any event, the theme and plots of defendants' television

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[10] We note, furthermore, that the Court relied on such cases as *Tompkins* v. *Halleck*, 1882, 133 Mass. 32, for the proposition that at common law performance of a play was not an abandonment of it to public use. In *Tompkins* the Supreme Judicial Court of Massachusetts abrogated the theory that a play might properly be copied from memory after witnessing a performance, adopting instead the the[illegible] that even a reproduction from memory violated the implicit license of the spectator's ticket of admission. Were it necessary, we might question whether the same result would apply to a free open-air performance where the audience is limited only by conditions of visibility, and no license might be implied.

series could not be said to have derived from anything created by plaintiff which was not revealed by his cards.

The cards were unquestionably "writings" within the meaning of the copyright clause, and arguably were copyrightable under the statute. *See* 17 U.S.C. §§ 1, 5(g) 5(k); *Burrows-Giles Lith. Co.* v. *Sarony*, 1883, 111 U.S. 53. The consequence is that the plaintiff's character-creation was published, even under the doctrine of *Ferris*, and that this case falls squarely under the rule of *Sears* and *Compco*. Not having copyrighted the cards, the plaintiff cannot preclude others from copying them. We accordingly reverse.

On the same day, May 11, 1967, the following judgment was entered:

Judgment

May 11, 1967

This cause came on to be heard on appeals from the United States District Court for the District of Rhode Island, and was argued by counsel.

Upon consideration whereof, It is now here ordered, adjudged and decreed as follows: The judgments of the District Court are vacated, the verdicts are set aside, and the cause is remanded with directions to enter judgments for defendants on the first cause of action. No costs on appeals.

By the Court:

Enter: /s/ ROGER A. STINCHFIELD
/s/ ALDRICH, Ch.J. *Clerk.*

Thereafter, on May 26, 1967, mandate herein issued.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

No. 693

VICTOR DECOSTA,

Petitioner,

v.

COLUMBIA BROADCASTING SYSTEM, INC., CAPITAL CITIES BROADCASTING CORPORATION and CBS FILMS, INC.,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

No. 693

VICTOR DECOSTA,

Petitioner,

v.

COLUMBIA BROADCASTING SYSTEM, INC., CAPITAL CITIES BROADCASTING CORPORATION and CBS FILMS, INC.,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

Questions Presented

The petition for certiorari (pp. 2, 3) attempts to present questions which completely ignore the proceedings below in the United States District Court for the District of Rhode Island, wherein only a cause of action alleging quasi-contractual obligations (unjust enrichment) or misappropriation without passing off was submitted to the jury (R. App. 14-16, 355, 356). Only this substantive claim could have been considered by the United States Court of Appeals for the First Circuit (Petition for Certiorari Appendix, pp. 6a, 7a).

The only question properly before the Court of Appeals and the only issue decided by that court was whether the trial record could support a jury award to Petitioner on

a theory of quasi-contractual liability (unjust enrichment) or misappropriation without passing off. Inherent in the reversal by the Court of Appeals is the conclusion that the trial record is completely devoid of any evidence which would support an *ex contractu* obligation of Respondents to Petitioner. Additionally, the Court of Appeals reached the completely proper conclusion that Petitioner's unprotected publication of his "ideas", whether they were unprotected or merely unprotectible, precluded Petitioner from recovering under any state law theory of misappropriation, by whatever name Petitioner's legal theories were proffered.

A fair reading of the trial record (as contained in the Consolidated Record Appendix), and the Court of Appeals opinion herein (Appendix to Petition, pp. 2a-5a) clearly establishes that Petitioner failed in his requisite burden of proof in the establishment of the necessary elements for quasi-contractual recovery. *Miller* v. *Schloss,* 218 N. Y. 400 (1916); *Puente* v. *President & Fellows of Harvard College,* 248 F. 2d 799 (1st Cir. 1957), cert. den. 356 U. S. 947 (1958).

Petitioner's main reason for the granting of certiorari appears to be that the holding of the Court of Appeals constitutes an improper application of this Court's recent rulings in *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U. S. 225 (1964) and *Compco Corp.* v. *Day-Brite Lighting, Inc.*, 376 U. S. 234 (1964), and that accordingly, this Court should use this limited quasi-contract (unjust enrichment) or misappropriation without passing off claim for the purpose of "clarifying" *Sears* and *Compco.* This contention is entirely without merit. The opinion of the Court of Appeals falls clearly within the precepts of both *Sears* and *Compco.* Respondents therefore urge that certiorari be denied absent a clear showing that the Court of Appeals holding was erroneous in denying Petitioner recovery or that the holding is in conflict with this Court or another Court of Appeals.

Statement of the Case

Petitioner's Statement of the Case (pp. 4-9) insofar as it follows the language of the opinion of the Court of Appeals (Appendix to Petition, pp. 2a-5a) is basically correct as far as it goes.

Naturally, Petitioner omits any reference to Respondents' creation and development of a television series entitled "Have Gun-Will Travel" independant of Petitioner or to Petitioner's absolute lack of privity or relationship with any of the Respondents (R. App. 77-78).

In 1956 two Hollywood writers, Herb Meadow and Sam Rolfe, submitted to Hunt Stromberg, Jr., then a Program Development Executive at Columbia Broadcasting System, Inc. (hereinafter "CBS"), an outline suggestion for a television series entitled "Have Gun-Will Travel" (R. App. 221-224). The suggestion featured a "knight errant" character named "Paladin" in a modern setting (R. App. 224-225) which was later changed at Mr. Stromberg's request to the old west (R. App. 226, 227-231, 253, 334). Thereafter a so-called pilot script was written, submitted and approved (R. App. 231-233), and (in late 1956) a pilot film produced (R. App. 295, *et seq.*).

In the pilot film the actor Richard Boone was screen-tested and costumed under the direction of Julian Claman, a staff producer for CBS (R. App. 283, 291-292, 337). For the show a calling card showing a knight chess piece with the printed words "Have Gun-Will Travel", "Wire Paladin", was designed at Mr. Claman's request by Charles Sibus of the CBS art department (R. App. 287-289, 305-307, 346-348, D. Ex. S and Y; R. App. 395, 397).

The first episode in the series was televised in September, 1957 (R. App. 107) over the CBS Television Network, including stations owned by Respondent Capital Cities Broadcasting Corporation. Thereafter other episodes, 225 in all (R. App. 328), were filmed and broadcast.

In this action commenced in June, 1963, Petitioner claimed that he created a legendary western hero named "Paladin" and that the Respondents wrongfully appropriated this idea (R. App. 14, 15). However, Petitioner introduced no evidence that he authored the creation of or even created a literary or legendary western character. His whole case was predicated on evidence that he appeared in public without remuneration beginning in the late 1940's attired in a black western outfit (R. App. 26-32, 86-87, 92-93, 100-106, 369, 389, 393), and further that he distributed uncopyrighted printed cards with the slogan "Have Gun, Will Travel" and a knight chess piece printed thereon together with the words "Wire Paladin" and uncopyrighted photographs of himself in said western outfit (P. Ex. 1, 2, 8, 15, 16, 17, 18, 19, 20, 21, 48 and 52; R. App. 369-385, 631, 632, 639 and 640), all over a period of years to the general public (R. App. 49, 51, 76, 77, 83, 89, 99). Moreover, Petitioner testified that he did not communicate his so-called idea for a black costume and calling card to anyone connected with Respondents prior to the origination of the television show (R. App. 77-78).

Petitioner probably should not be faulted for his rather one-sided statement of the case; he obviously believes it to be to his advantage. It is not; for Petitioner's assertion that Respondents did not object to the jury instruction to the effect that he was entitled to a verdict if he established that he created a novel, original and unique idea and character, that he had not abandoned said idea and character, that Respondents copied said idea and character without permission, and that Petitioner sustained damages thereby, is clearly not supported by the record. Not only did Respondents object to the above-stated portion of the Trial Court's charges to the jury (R. App. 364-365), but Respondents also timely objected to the Trial Court's denial of Respondents' requests for relevant and proper instructions (R. App. 366, 399-402).

Reasons for Denying the Writ

I. The Court of Appeals holding does not result in any conflict of decisions.

Petitioner's arguments appear to seek a sweeping appraisal and clarification of *Sears* and *Compco, supra.* However, the proper question to be presented here is not the extent to which *Sears* and *Compco* can be applied in the copyright field, but merely whether the Court of Appeals, and even perhaps by dicta, correctly applied the rationale of *Sears* and *Compco.*

The Court of Appeals properly disregarded any issue of "secondary meaning" or "passing off". These issues were only susceptible of proof under those claims reserved by the Trial Court (Pet. App. 6a, 7a). It concluded "thus, the judgment can only be supported on a rule of law that would allow recovery upon proof of creation by the plaintiff and copying by the defendants, and nothing else. We do not find such a rule in the cases cited above." [See *Lone Ranger, Inc.* v. *Cox*, 124 F. 2d 650 (4th Cir. 1942); *Chaplin* v. *Amador*, 93 Cal. App. 358, 269 Pac. 544 (1928); *Lahr* v. *Adell Chem. Co.*, 300 F. 2d 256 (1st Cir. 1962); *Metropolitan Opera Ass'n* v. *Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 793 (N. Y. Sup. Ct. 1950), aff'd 279 App. Div. 632 (1st Dep't 1951)] (Pet. App. 7a).

Before dealing with the application of *Sears* and *Compco*, one might ask what does the trial record offer in support of Petitioner's so-called "creation"? He had a black western costume, a Paladin alias, and calling cards containing the slogan "Have Gun-Will Travel", the symbol of a knight chess piece and the words "Wire Paladin"; some of the cards even contained a picture of Petitioner in costume. Photographs of this Rhode Island "Paladin" were also generally distributed. As a hobby Petitioner appeared at horseshows, rodeos and parades in and around the Provi-

dence, Rhode Island area and indiscriminately disseminated approximately 250,000 of these calling cards and pictures to anyone and everyone who might want them, all without restriction or limitation as to persons or purpose (R, App. 49, 51, 76, 77, 83, 89, 99).

The first question to be determinated is whether Petitioner's *creation* constituted an idea or literary property. If it was an idea, it was uncopyrightable and not literary property. Absent the legal requisite contractual protection or a confidential disclosure to Respondents, they were perfectly free to utilize any of his ideas.

If the *creation* achieved the dignity of literary property and was therefore copyrightable, Petitioner in failing to seek statutory protection for his property and freely publishing whatever he had without statutory requisites for protection forfeited his common law rights (see Point II, *infra*).

It is Respondents' contention that the established law of ideas precludes Petitioner from any recovery herein, irrespective of *Sears* and *Compco* (see Point II, *infra*), and that *Sears* and *Compco* merely lock doors which have long been closed.

The court stated in *Compco* at page 237:

> "Today we have held in *Sears, Roebuck & Co.* v. *Stiffel, supra,* that when an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article. To forbid copying would interfere with the federal policy, found in Art. I, Sec. 8, Cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."

It follows that state laws cannot afford legal protection to the copying of public domain material, i.e., that matter which is inherently uncopyrightable or that matter which

is copyrightable, but forfeited. Any contrary interpretation would permit perpetual protection (a) to one who is the proprietor of an uncopyrightable work or (b) to one who fails to secure statutory registration (Title 17, U.S.C., § 1 *et seq.*) for published copyrightable material. With respect to uncopyrightable works, *Sears* held the following at page 232:

> "... because of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying."

The citation for this statement is a copyright decision of Judge Learned Hand in *G. Ricordi & Co.* v. *Haendler,* 194 F. 2d 914 (2d Cir. 1952). That Court of Appeals' decision held that copyrightable elements of the work were dedicated to the public upon publication of the work, and that accordingly, when the copyright on the work expired, anyone was free to actually photograph the then uncopyrightable elements. From this citation, it is crystal clear that state law cannot protect uncopyrightable matter or copyrighable matter in the public commons.

Petitioner argues at length that the Court of Appeals' application of *Sears* and *Compco* conflicts with *International News Service* v. *Associated Press,* 248 U. S. 215 (1918). While it is true that *Sears* and *Compco* did not specifically mention *I.N.S.* v. *A. P., supra,* it is apparent that *I.N.S.* v. *A. P.* cannot grant protection absent palming off or misrepresentation. The problem of any possible conflict between *Sears* and *Compco* and *I.N.S.* v. *A. P.* was dealt with in *Cable Vision, Inc.* v. *KUTV, Inc.,* 335 F. 2d 348 (9th Cir. 1964), cert. den. 379 U. S. 989 (1965). In *Cable Vision,* unfair competition and tortious interference with contractual rights was claimed by a local television station against a CATV operator. That Court of Appeals held at page 350:

> "As we read Sears and Compco, however, only actions for copyright infringement or such common-law actions

as are consistent with the primary right of public access to all in the public domain will lie.

In Compco, the court emphasized that the federal policy found in Art. I, § 8, Cl. 8 of the Constitution and in the implementing federal statutes is to allow '* * * free access to copy whatever the federal patent and copyright laws leave in the public domain.' 376 U. S. at 237, 84 S. Ct. at 782. The public domain was broadly delineated in Sears: that which is either not copyrighted, not copyrightable or on which the copyright has expired is in the public domain. 376 U. S. at 231, 84 S. Ct. 784. See also Flamingo Telefilm Sales Inc. v. United Artists Corp., 32 U. S. L. Week 2579 (May 12, 1964). Thus when an article is unprotected by a patent or copyright, state law may not forbid a person not the originator to merely copy and commercially exploit that article, for such a law would enable the originator to accomplish with the left hand of state authority what he was unable to accomplish with the right hand bearing the authority of the primary federal interest."

It went on to distinguish *I.N.S.* v. *A. P.* and perhaps even hail the present pendulum swing to the dissent of Justice Brandeis. That Court of Appeals seriously questioned the applicability of *I.N.S.* v. *A. P.* today. But regardless of that fact and just as in *Cable Vision,* the instant case is readily distinguishable from *I.N.S.* v. *A. P.* in that there is no issue present of palming off or misrepresentation. As the Court of Appeals said in *Cable Vision,* at page 351:

"Here the District Court enjoined activity that lacked the element of palming off. It is incontrovertible that all broadcasts are received and distributed by the community antenna without any modification of program content; therefore no question of 'implied misrepresentation' by failing to give the originator proper credit, a misrepresentation present in International

> News Service v. Associated Press, supra, 248 U. S. 215, 39 S. Ct. 68 (1918), is involved in this case. We are clear that there is lacking that taint 'necessary to turn a flavor into a poison' justifying judicial relief without Congressional authorization. To the extent, then, that the District Court holding extended a new protectible interest beyond what the copyright laws confer, it '* * * interfere[d] with the federal policy * * * of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain.' "

Similar applications of *Sears* and *Compco* with respect to uncopyrightable or uncopyrighted matters have been reached in *G. P. Putnam's Sons* v. *Lancer Books, Inc.*, 239 F. Supp. 782 (SDNY 1965); *Estate of Hemingway* v. *Random House, Inc.*, 49 Misc. 2d 726, 153 U.S.P.Q. 871 (N. Y. Sup. Ct. 1967); *Flamingo Telefilm Sales, Inc.* v. *United Artists Corporation*, 22 A. D. 2d 778 (1st Dep't 1964), 144 U.S.P.Q. 168.

In his petition, Petitioner devotes most of his argument to the point that *Sears* and *Compco* should not preclude recovery where there is an actual passing off or misrepresentation (absent here). Every pre *Sears* and *Compco* case cited by Petitioner in support of his contention that the *Sears* and *Compco* pre-emption doctrine should not be applied contains the present record missing elements of passing off or misrepresentation. The same holds true for each post *Sears* and *Compco* decision cited by Petitioner.

The remainder of Petitioner's argument is directed to broad generalizations involving the need for federal legislation to protect that which at present is unprotectible, and how Petitioner's undefined rights should still be protected by common law on the grounds that Petitioner has not *published* whatever it is he had.

With respect to all issues raised by Petitioner, the Court of Appeals' application of *Sears* and *Compco* is entirely

consistent with the *Sears* and *Compco* holdings and does not conflict with any subsequent holding of this Court or of any other Court of Appeals. For this reason alone, the Petition for Certiorari should be denied.

II. The Court of Appeals reversal is correct, even without reliance on *Sears and Compco*.

While it is clear that the Court of Appeals' application of *Sears* and *Compco* is correct and precludes Petitioner from any redress (see Point I, *supra*), it is Respondents' contention that Petitioner is not entitled to recovery under the single claim before this Court.

Referring to Petitioner's sole adjudicated claim (Petition for Certiorari Appendix, pp. 6a, 7a), it is clear that he is attempting to recover under a quasi-contractual theory (unjust enrichment), whereunder he must prove:

1. Independent creation of a unique and novel idea or combination of ideas,
2. reduced to concrete form, plus
3. contract protection upon disclosure to Respondents, or its equivalent, and a
4. wrongful taking of Petitioner's idea or combination of ideas by Respondents, with
5. resultant damage to Petitioner.

Absent proof of *any* of the above elements, there can be no recovery. It is Respondents' contention that Petitioner totally failed to offer proof on *all* of the following necessary elements to support such a quasi-contractual recovery:

1. *Independent creation of a unique and novel idea or combination of ideas, reduced to concrete form.*

Petitioner was admittedly not performing any literary material at any time and he did not possess scripts or re-

corded spoken lines. Petitioner had merely put together a costume and a calling card, which together with his assumed name "Paladin" were borrowed from some other source (R. App. 30-31, 36-37, 38-40, 52-53, 124-125). Petitioner created nothing which can be classified as literary in nature. His idea was never reduced to written concrete form (for the basis of a television production or any other type of dramatic performance). Even a novel abstract idea for a character does not become concrete until there is some readable expression of when, where, how (and even, why) the character will function. The very least that must be required is the outline of how the novel and concrete idea can be presented dramatically. Even then there must be detail and substance set forth in order to make the idea useful and workable.

Bowen v. *Yankee Network, Inc.*, 46 F. Supp. 62 (D. Mass. 1942);
Herwitz v. *National Broadcasting Company*, 210 F. Supp. 231 (SDNY 1962);
O'Brien v. *RKO Radio Pictures, Inc.*, 68 F. Supp. 13 (SDNY 1946);
Taylor v. *Metro-Goldwyn-Mayer Studios*, 115 F. Supp. 156 (S. D. Cal. 1953);
Plus Promotions, Inc. v. *RCA Mfg. Co.*, 49 F. Supp. 116 (SDNY 1943).

2. *Contract protection upon disclosure to Respondents or its equivalent.*

It is well established by the authorities that the disclosure of an idea, or publication of a work without first securing statutory copyright protection, deprives the originator of any rights.

Puente v. *President & Fellows of Harvard College, supra;*
Affiliated Enterprises, Inc. v. *Gruber*, 86 F. 2d 958 (1st Cir. 1936);

White v. *Kimmell,* 193 F. 2d 744 (9th Cir. 1952), cert. den. 343 U. S. 957 (1952);

Continental Casualty Company v. *Beardsley,* 253 F. 2d 702 (2d Cir. 1958), cert. den. 358 U. S. 816 (1958);

American Code Co. v. *Bensinger,* 282 Fed. 829 (2d Cir. 1922);

Jewelers' Mercantile Agency v. *Jewelers' Weekly Pub. Co.,* 155 N. Y. 241, 49 N. E. 872 (1898);

Varconi v. *Unity Television Corporation,* 173 N.Y.S. 2d 201 (Sup. Ct. 1958).

The rule was concisely set forth in the *Puente* case at page 802:

> "The unconditional public disclosure of an idea by the originator makes it the property of all and operates to deprive the originator of any further proprietary rights in it."

An idea or the expression thereof can be protected by the originator in only three ways: (1) the originator of an idea may keep it secret; (2) he may disclose it to a potential user with contract protection or its equivalent without losing rights; and (3) if he wants to publish it generally, he must put his "ideas" in some literary form and secure statutory copyright. See

> 2 Callman, *Unfair Competition and Trade-Marks,* 917-918 (2d ed. 1950),

where it is stated as follows:

> "Though the common-law protection available for ideas appears under various names, the common denominator has not yet been identified. Whether we speak of a common-law copyright, a trade secret or the rights of an inventor in his unpatented invention,

the root is always the same. We do not actually look to the nature of the copyright, trade secret, or invention, nor at their contents and their value, but merely at the *fact of their secrecy*. When secrecy disappears, the idea is available to all unless a particular legal regulation comes to the rescue. This may arise from the copyright or patent law or from a confidential or similarly special relationship." (emphasis by the author.)

There was no privity or confidential relationship (or possible equivalent) between Petitioner and Respondents in this case. In fact, Petitioner admits that he never made any disclosure of his idea(s) to Respondents. He had no contact with Respondents prior to the first television broadcast of "Have Gun-Will Travel". It is important to stress again that Petitioner is seeking recovery on a quasi-contractual (or unjust enrichment) theory, not a tort theory. Petitioner has failed to cite a single case where a quasi-contract was found to exist in an idea-theft case absent any privity or confidential relationship between the parties; this is for the simple reason that no such case exists. The law simply does not imply contracts out of the air. There must be some relationship between the parties from which a contract can be implied in law.

Assuming *arguendo* that one of the Respondents saw Petitioner in western dress, received one of the approximately 250,000 cards which Petitioner admittedly passed out indiscriminately or a picture of Petitioner in costume dress, what obligation do Respondents have to Petitioner if they incorporated some of these freely published elements into a fictitious literary characterization in a television program? It is submitted that the answer is none.

Official Airlines Schedule Information Service, Inc. v. *Eastern Air Lines, Inc.*, 333 F. 2d 672 (5th Cir. 1964);

Cobb v. *Southern Plaswood Corporation,* 171 F. Supp. 691 (W. D. Ark. 1959);

Van Rensselaer v. *General Motors Corporation,* 223 F. Supp. 323 (E. D. Mich. 1962), aff'd 324 F. 2d 354 (6th Cir. 1963);

Puente v. *President & Fellows of Harvard College, supra;*

Bowen v. *Yankee Network, Inc., supra;*

Carneval v. *William Morris Agency, Inc.,* 124 N.Y.S. 2d 319 (1953), aff'd 284 App. Div. 1041; 137 N.Y.S. 2d 612 (1st Dep't 1954);

Grombach Productions, Inc. v. *Waring,* 293 N. Y. 609; 59 N. E. 2d 425 (1944);

Matarese v. *Moore-McCormack Lines, Inc.,* 158 F. 2d 631 (2d Cir. 1946);

Sloan v. *Mud Prods., Inc.,* 114 F. Supp. 916 (N. D. Okla. 1953);

Herwitz v. *National Broadcasting Company, supra.*

Under the law of ideas, any disclosure of an idea without contract protection or its equivalent results in a forfeiture or dedication thereof, *Bristol* v. *Equitable Life Assurance Society of New York,* 132 N. Y. 264, 267 (1892); and ideas *per se,* regardless of how concrete the form, are, not, independent of contract protection or its equivalent, protectible property at common law. *Grombach Productions, Inc.* v. *Waring, supra; Carneval* v. *William Morris Agency, Inc., supra.* Literary and artistic expression, i.e., that which is copyrightable, is property *per se* and protectible at common law up to the time of initial publication. *Palmer* v. *DeWitt,* 47 N. Y. 532, 536 (1872). It follows then that Petitioner's uncopyrightable character, characterization or idea must have fallen into the public domain during his years of non-commercial exploitation and public exhibition thereof, i.e., 1947 to 1957 (R. App. 32, 33, 38).

3. A wrongful taking of Petitioner's idea or combination of ideas by Respondents.

In order for Petitioner to recover for "idea theft", it is necessary for him to prove that the Respondents wrongfully appropriated his ideas. Petitioner presented no direct proof of copying or even access to Petitioner's ideas.

Herwitz v. *National Broadcasting Company, supra;*

Richards v. *Columbia Broadcasting System, Inc.,* 161 F. Supp. 516 (D.D.C. 1958);

Costello v. *Loew's Incorporated,* 159 F. Supp. 782 (D.D.C. 1958);

Harold Lloyd Corporation v. *Witwer,* 65 F. 2d 1 (9th Cir. 1933);

Twentieth Century-Fox Film Corp. v. *Dieckhaus,* 153 F. 2d 893 (8th Cir. 1946), cert. den. 329 U. S. 716 (1946);

Golding v. *RKO Pictures, Inc.,* 35 Cal. 2d 690, 221 P. 2d 95 (1950);

Smith v. *Berlin,* 207 Misc. 862; 141 N.Y.S. 2d 110 (1955);

Schwarz v. *Universal Pictures Co.,* 85 F. Supp. 270 (S. D. Cal. 1945);

Lapsley v. *American Institute of Certified Public Accountants,* 246 F. Supp. 389 (D.D.C. 1965);

Columbia Pictures Corporation v. *Krasna,* 65 N.Y.S. 2d 67 (1946), aff'd 271 App. Div. 1008; 69 N.Y.S. 2d 796 (1st Dep't 1947);

Pinci v. *Twentieth Century-Fox Film Corp.,* 95 F. Supp. 884 (S.D.N.Y. 1951);

Teich v. *General Mills, Inc.,* 339 P. 2d 627 (Cal. App. 1959);

Huszar v. *Cincinnati Chemical Works, Inc.,* 172 F. 2d 6, 11 (6th Cir. 1949).

Even if the "'coincidence' run riot" suggestion (Pet. App., p. 2a) is intended to infer that Respondents or one of their agents might have seen Petitioner (his picture) or his calling card, there would still be no wrongful use in that any of the ideas embodied in his appearance, card or photograph were forfeited and dedicated to the public; anyone was free to use them.

4. *Petitioner has not been damaged.*

There is not one shred of evidence in the entire trial record which supports damage to Petitioner. He did not sell a product, service or institution; he did not charge fees for appearances; he exploited only himself (R. App., p. 3a). His "totem of creation" was for personal pleasure as opposed to economic exploration. Record evidence of Respondents' gross sales in monetary terms could not support the claim of money damage.

Weitzenkorn v. *Lesser,* 40 Cal. 2d 778; 256 P. 2d 947 (1953);

Universal Pictures Co. v. *Harold Lloyd Corporation,* 162 F. 2d 354 (9th Cir. 1947);

Golding v. *RKO Pictures, Inc., supra;*

Cole v. *Phillips H. Lord, Inc.,* 262 App. Div. 116; 28 N.Y.S. 2d 404 (1st Dep't 1941);

Illinois Cent. R. Co. v. *Howard,* 196 Ind. 323; 147 N. E. 142 (1925).

The only other question raised by Petitioner is in the area of "publication". He argues that he retained common law rights in his *character* on the legal concept that there was no performance or publication of his *character,* photographs or business cards sufficient to constitute a forfeiture or dedication to the public.

The legal rationale that public performance in and of itself does not constitute a general publication is obviously

inapplicable to this case. The principle can only apply to performances of literary material, and that material which is not already published.

Ferris v. *Frohman*, 223 U. S. 424 (1912);
Nutt v. *National Institute Incorporated for the Improvement of Memory*, 31 F. 2d 236 (2d Cir. 1929);
Continental Casualty Company v. *Beardsley*, *supra*.

There was no testimony in the record of this case from which the jury could find that Petitioner performed literary material. He admitted that he had no scripts (R. App. 84). In addition, the only possible literary material which he possessed, i.e., his calling card, or possibly his photographs, were both printed and published by circulation without restriction. Therefore, under no conceivable view of the evidence could it be concluded that the claimed rule on public performance was applicable to this case.

Even with respect to Petitioner's so-called performance, the Court of Appeals rationale is also correct. Performance, while it may not divest a proprietor of statutory rights, does constitute publication and hence, divestment of common law rights in the work performed.

Shapiro, Bernstein & Co. v. *Miracle Record Co.*, 91 F. Supp. 473 (N. D. Ill. 1950);
Hirshon v. *United Artists Corp.*, 243 F. 2d 640, 644 (D. C. Cir. 1957);
McIntyre v. *Double-A. Music Corp.*, 166 F. Supp. 681 (S. D. Cal. 1958);
Mills Music, Inc. v. *Cromwell Music, Inc.*, 126 F. Supp. 54 (SDNY 1954).

CONCLUSION

The Court should deny the Writ of Certiorari.

Respectfully submitted,

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